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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/598,677	09/07/2006	Michiaki Koizumi	062981	8754

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EXAMINER

NGUYEN, HAI V

ART UNIT	PAPER NUMBER
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2618

MAIL DATE	DELIVERY MODE
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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/598,677	Applicant(s) KOIZUMI ET AL.	
	Examiner HAI V. NGUYEN	Art Unit 2618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to ^{application} communication(s) filed on 07 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☒ Claim(s) 8-9, 12-13 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09/07/2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>9/7/06; 7/25/07; 11/13/07</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action is in response to the application filed on 07 September 2006.
2. Claims 1-20 are presented for examination.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claim 20 is rejected under 35 U.S.C. 101 because the claims 1, 14, 16 recite the element of "a program" which reads in light of specification amounts to nothing more than computer software void of a computer readable medium. See MPEP 2106(V) (B) (1).

5. Claim 20 fails to fall within a statutory category of invention. It is directed to the program itself, not a process occurring as a result of executing the computer program, a machine programmed to operate in accordance with the computer program nor a manufacture structurally and functionally interconnected with the computer program in a manner which enables the program to act as a computer component and realize its functionality, It's also clear not directed to a composition of matter. Therefore, it is non-statutory under 35 USC 101.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-7, 10-11, 14-20 are rejected under 35 U.S.C. 102(e) as being anticipated by **Dietz et al. US patent # 7,319,869 B2**.

8. As to claim 1, Dietz discloses substantially the invention as claimed, including a mobile terminal (*Fig. 1, element 100*) having a broadcast program receiving function in addition to a communication function (*telephone calls*), comprising: a memory (*Fig. 1, element 104*);
a recording unit (*Fig. 2, record button element 408 associated with CPU 200*) operable, when playback of a broadcast program being received is disabled by the communication function, to record the broadcast program in the memory as broadcast data, the communication function having priority over the playback (*Fig. 1, col. 2, line 66 – col. 3, line 13; col. 5, lines 34-52*); and
a playback unit operable, when the disabled playback changes to be enabled, to play back the broadcast data (*Fig. 1, col. 2, line 66 – col. 3, line 13; col. 5, lines 34-52*).

9. As to claim 2, Dietz discloses, wherein the playback is disabled either on receipt of an incoming call having priority over the playback, on commencement of a call, or on

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occurrence of another situation (*Fig. 1, col. 2, line 66 – col. 3, line 13; col. 5, lines 34-52*), and

the disabled playback changes to be enabled when the priority over the playback is cancelled (*Fig. 1, col. 2, line 66 – col. 3, line 13; col. 5, lines 34-52*).

10. As to claim 3, Dietz discloses, wherein the playback unit includes a first playback subunit (*Fig. 4, play button 404*) operable to receive a specification of a playback speed from a user and play back the recorded broadcast data at the specified playback speed (*Fig. 1, col. 2, line 66 – col. 3, line 13; col. 3, lines 44-61; col. 4, lines 15-29; the CPU 200 allows a user to manipulate the presentation of audio data 212 through various functions such as reverse, fast forward, skip commercials*).

11. As to claim 4, Dietz discloses, wherein the first playback subunit includes: a standard playback subunit (*Fig. 4, play button 404*) operable to play back the recorded broadcast data at a standard playback speed equal to an original playback speed of the broadcast program; and a high-speed playback subunit (*Fig. 4, fast forward button 406*) operable to play back the broadcast data at a playback speed higher than the standard playback speed (*Fig. 1, col. 2, line 66 – col. 3, line 13; col. 3, lines 44-61; col. 4, lines 15-29; the CPU 200 allows a user to manipulate the presentation of audio data 212 through various functions such as reverse, fast forward, skip commercials*).

12. As to claim 5, Dietz discloses, wherein the first playback subunit further includes a special playback subunit, operable to perform slow playback and reverse playback during the playback of the recorded broadcast data (*Fig. 1, col. 2, line 66 – col. 3, line 13; col. 3, lines 44-61; col. 4, lines 15-29; the CPU 200 allows a user to manipulate the*

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presentation of audio data 212 through various functions such as reverse, fast forward, skip commercials).

13. As to claim 6, Dietz discloses, wherein the high-speed playback subunit includes a calculation subunit operable to receive a remaining playback time period from the user, and calculate, based on a predetermined formula, a playback speed indicating a number of frames to be played back per second, and the high-speed playback subunit reads the broadcast data from the memory, and plays back the read broadcast data at the calculated playback speed (*Figs. 2-6, col. 2, line 66 – col. 3, line 13; col. 3, lines 44-61; col. 4, lines 15-29; the CPU 200 allows a user to manipulate the presentation of audio data 212 through various functions such as reverse, fast forward, skip commercials).*

14. As to claim 7, Dietz discloses, wherein when another incoming call is received during the playback or when another call starts, the playback unit interrupts the playback, the calculation subunit recalculates a playback speed based on the predetermined formula, and an output subunit (*Fig. 1, display element 120*) outputs the recorded broadcast data from an interrupted part, to a monitor at the re-calculated playback speed (*Figs. 2-6, col. 2, line 66 – col. 3, line 13; col. 3, lines 44-61; col. 4, lines 15-29; the CPU 200 allows a user to manipulate the presentation of audio data 212 through various functions such as reverse, fast forward, skip commercials).*

15. As to claim 10, Dietz discloses, wherein the high-speed playback subunit includes a calculation subunit operable to receive a remaining playback time period from the user, and calculate, based on a predetermined formula, a playback speed

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indicating a number of frames to be played back per second, and the high-speed playback subunit reads the broadcast data from the memory, and plays back the read broadcast data at the calculated playback speed (*Figs. 2-6, col. 2, line 66 – col. 3, line 13; col. 3, lines 44-61; col. 4, lines 6-29; the CPU 200 allows a user to manipulate the presentation of audio data 212 to synchronize with the live current audio broadcast*).

16. As to claim 11, Dietz discloses, wherein when another incoming call is received during the playback or when another call starts, the playback unit interrupts the playback, the calculation subunit recalculates a playback speed based on the predetermined formula, and an output subunit (*Fig. 1, display element 120*) outputs the recorded broadcast data from an interrupted part, to a monitor at the re-calculated playback speed (*Figs. 2-6, col. 2, line 66 – col. 3, line 13; col. 3, lines 44-61; col. 4, lines 15-29; the CPU 200 allows a user to manipulate the presentation of audio data 212 through various functions such as reverse, fast forward, skip commercials*).

17. As to claim 14, Dietz discloses, wherein when broadcasting of the broadcast program being played back ends, the recording unit stops recording the broadcast program (*Figs. 2-6, col. 2, line 66 – col. 3, line 13; col. 3, lines 44-61; col. 4, lines 15-29; the CPU 200 allows a user to manipulate the presentation of audio data 212 through various functions such as reverse, fast forward, play, record, skip commercials*).

18. As to claim 15, Dietz discloses, wherein when the playback of the recorded broadcast data by the second playback subunit or the high-speed playback subunit catches up with the real-time broadcast, or when broadcasting of the broadcast program being played back ends during the playback of the recorded broadcast data by the

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standard playback subunit, the recording unit stops recording the broadcast program (Figs. 2-6, col. 2, line 66 – col. 3, line 13; col. 3, lines 44-61; col. 4, lines 15-29; the CPU 200 allows a user to manipulate the presentation of audio data 212 through various functions such as reverse, fast forward, skip commercials).

19. As to claim 16, Dietz discloses, wherein the playback unit further includes a second playback subunit (a user input) operable, when the specification of the playback speed is not received, to play back the recorded broadcast data at a default playback speed suitable for hearing audio (Figs. 2-6, col. 2, line 66 – col. 3, line 13; col. 3, lines 44-61; col. 4, lines 15-29; the CPU 200 allows a user to manipulate the presentation of audio data 212 through various functions such as reverse, fast forward, skip commercials).

20. As to claim 17, Dietz discloses, wherein the second playback subunit plays back the recorded broadcast data at a playback speed within a range from 1.0 time to 2.0 times the standard playback speed (Figs. 2-6, col. 2, line 66 – col. 3, line 13; col. 3, lines 44-61; col. 4, lines 15-29; col. 5, lines 34-52).

21. As to claim 18, Dietz discloses, wherein when the playback of the recorded broadcast data by the second playback subunit or the high-speed playback subunit catches up (synchronizes) with the real-time broadcast, or when broadcasting of the broadcast program being played back ends during the playback of the recorded broadcast data by the standard playback subunit, the recording unit stops recording the broadcast program (Figs. 2-6, col. 2, line 66 – col. 3, line 13; col. 3, lines 44-61; col. 4, lines 15-29; col. 5, lines 34-52).

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22. As to claim 19, Dietz discloses substantially the invention as claimed a method for recording and playing back a broadcast program in a mobile terminal (*Fig. 1, computing unit element 100*) having a broadcast program receiving function in addition to a communication function (*telephone calls*), the method comprising the steps of: recording, when playback of a broadcast program (*an audio broadcast presentation*) being received is disabled by the communication function, the broadcast program in the memory as broadcast data, the communication function having priority over the playback (*Fig. 1, col. 2, line 66 – col. 3, line 13; col. 5, lines 34-52*); and playing back, when the disabled playback changes to be enabled, the broadcast data (*Fig. 1, col. 2, line 66 – col. 3, line 13; col. 5, lines 34-52*).

23. Claim 20 corresponds to the computer readable medium claim of claim 19; therefore, it is rejected under the same rationale as in claim 19.

Allowable Subject Matter

24. Claims 8-9, 12-13 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

25. Further references of interest are cited on Form PTO-892, which is an attachment to this action.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HAI V. NGUYEN whose telephone number is (571)272-3901. The examiner can normally be reached on 6:00-3:30 Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew Anderson can be reached on 571-272-4177. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Hai V. Nguyen
Examiner
Art Unit 2618


MATTHEW ANDERSON
SUPERVISORY PATENT EXAMINER